



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,712	06/26/2003	Akihiko Suyama	393032038600	6937
7590 David L. Fehrman Morrison & Foerster LLP 35th Floor 555 W. 5th Street Los Angeles, CA 90013		12/18/2008	EXAMINER CHOW, VAN NGUYEN	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 12/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/608,712

Applicant(s)

SUYAMA, AKIHIKO

Examiner

Van N. Chow

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/29/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 1, 10, 19 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 5-8, 11, 12, 14-17, 20, 23, 27 and 30-52 is/are rejected.
- 7) ☒ Claim(s) 4, 9, 13, 18, 21, 24-26, 28 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/608,712, filed on June 26th, 2003. Also, the English translation of this foreign application is acknowledged.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **2-3,11-12, 20, 23, 27 and 30-32, 39-41, 48-49 and 51** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Taira et al. (US 5,809,003)** in view of Kobayashi (EP 1049079).

Regarding claim 2, Taira discloses a method of forming a visual image having a specified shape on a surface of an optical disk by using an optical writing process of irradiating a laser beam onto the surface of the optical disk to form pits, the optical disk having a program are along the surface of the optical disk for recording information and being capable of recording information in the program area by the optical writing process (see abstract), the method comprising the steps of:

acquiring image formation information associated to a visual image to be formed (see Figs. 2, 5); forming the visual image in the program are of the optical disk based on the acquired image formation information by using the optical writing process (see Figs. 2-5, abstract, cols. 1- 2).

Kobayashi discloses an optical disk having desired data recorded thereon by pits formed on an information recording surface, comprising: a desired visible image and said desired data being recorded on said information recording surface simultaneously; therefore, record the image formation information in the same optical disk by using the optical writing process (see Kobayashi abstract, Fig. 6,).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an optical disk having desired data recorded thereon by pits formed on an information recording surface, comprising: a desired visible image and said desired data being recorded on said information recording surface simultaneously in Taira, as suggested by Onodera, the motivation being in order to record a desired visible image and said desired data being recorded on said information recording surface simultaneously (see Kobayashi abstract, Fig. 6).

Regarding claim 3, the combination of Tarai and Kobayashi, discloses the method according to claim 2, further comprising the step of placing the optical disk in a recording end state after the image formation information is recorded so that the disk is made unable to additionally record information anymore (inherently).

Regarding claims 11, 20 and 23, 31, 39, 40, 48, 49, 51 see rejection above of claim 2.

Regarding claims 12, 32, 41, see rejection above of claim 3.

Regarding claim 27, the combination of Tarai and Kobayashi, discloses the method of claim 2, wherein the recording step records the image formation information which represents a pattern of irradiating the laser beam on the basis of a polar coordinates system defined on the surface of the optical disk (see Taira Fig. 5).

Regarding claim 30, see rejection above of claim 27.

Claims 5-8, 14-17, 34-37, 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taira et al. (US 5,809,003) in view of Onodera et al. (US 2001/0040867).

Regarding claim 5, the combination of Tarai and Kobayashi, discloses the method according to claim 2, wherein the step of recording records the image formation information containing start address information specifying a position of the surface of the optical disk to start the optical writing process for forming the visual image, stop address information specifying another position to stop the optical writing process for forming the visual image, and pattern information specifying a pattern of irradiating the laser beam during the optical writing process for forming the visual image (inherently). However, to be more specific, Onodera discloses the step of recording records the image formation information containing start address information specifying a position of the surface of the optical disk to start the optical writing process for forming the visual image, stop address information specifying another position to stop the optical writing process for forming the visual image, and pattern information specifying a pattern of irradiating the laser beam during the optical writing process for forming the visual image (see Fig. 11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide writing address in Taira, as suggested by Onodera, the motivation being in order to record the image formation information containing start address information specifying a position of the surface of the optical disk (see Onodera).

Regarding claim 6, the combination of Tarai and Kobayashi, see Fig. 5, discloses the method according to claim 2, wherein the step of recording records the image formation information containing image data which represents the visual image and which is recorded in a format readily readable from the optical disk for reproduction of the visual image.

Onodera discloses the image formation information containing image data which represents the visual image and which is recorded in a format readily readable from the optical disk for reproduction of the visual image on a display (see Fig. 3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a display unit in Taira, as suggested by Onodera, the motivation being in order to read a message for prompting an instruction about whether pit art recording of this bit map data can be started (see Onodera col. 5).

Regarding claims 7-8, or 34-35, or 36-37, 43-46, see rejection above of claims 5-6.

Regarding claim 14, see rejection above of claim 5.

Regarding claims 16-17, see rejection above of claim 7-8, respectively.

Regarding claim 15, see rejection above of claim 6.

Allowable Subject Matter

Claims 4, 9, 13, 18, 21 and 24-26, 28-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the cited references disclose or suggest all the limitations in parent claim including limitation placing the optical disk in a recording end state on the surface of the optical disk so that the optical disk is made unable to additionally. However, Onodera does not disclose the step of placing the optical disk in a recording end state while leaving a reserved area on the surface of the optical disk so that the optical disk is made unable to additionally record information except for the reserved area, wherein the step of recording records the image formation information in the reserved area after the optical disk is placed in the recording end state or placing the optical disk in a recording end state while an available area

is left in the program area of the optical disk, so that the optical disk is made unable to additionally record information on the available area anymore, wherein the visual image is formed in the available area of the optical disk by using the optical writing process, and the image formation information is recorded in the same available area of the program area by using the optical writing process.

None of the cited references disclose or suggest all the limitations in parent claim including limitation copying the image formation information recorded in the origin optical disk to the duplicate optical disk by using the optical writing process; and reproducing the visual image on the surface of the duplicate optical disk by using the optical writing process based on the copied image formation information.

Claim Cited References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references relate to an optical disk and a reproduction method reproduction apparatus, and recording apparatus for the same and information reproducing method judging a multi-valued level of a present cell by referring to judged multi-valued levels of a preceding cell and a ensuing cell.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN T. PHAM whose telephone number is 571-272-7590. The examiner can normally be reached on Monday-Thursday from 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Art Unit: 2627

Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Van N. Chow/
Examiner, Art Unit 2627

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627